



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,193	06/23/2003	Jean-Guy Cocaign	028811-25	6423

22204 7590 04/23/2004

NIXON PEABODY, LLP  
401 9TH STREET, NW  
SUITE 900  
WASHINGTON, DC 20004-2128

EXAMINER
----------

MORROW, JASON S

ART UNIT	PAPER NUMBER
----------	--------------

3612

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,193

Applicant(s)

COCAIGN, JEAN-GUY

Examiner

Jason S. Morrow

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/23/03</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the louvers must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

2. Claims 6 and 12 are objected to because of the following informalities: In lines 1 and 2, the claims use the phrase "comprise comprises". Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the side roof elements" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3612

Claim 1 recites the limitation "the inside surface of the glass" in line 11. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohm et al. '864 in view of Clenet.

Bohm et al. discloses a roof module for closing an opening in a roof of a motor vehicle that extends transversely between two lateral roof elements (figure 2, 6) and in a lengthwise direction between a front roof element (figure 3, 6) and a rear roof element (figure 4, 6), and side roof elements, the front roof element and the rear roof element, the roof module comprising a glass pane (5) adapted for permanent connection to peripheral rabbets (shown in figure 2 as part of 6) which border the opening, a darkening device (17) which is deployable parallel to an inside surface of the glass pane, guide means (27) for guiding the darkening device, the guide means being permanently mounted on the inside surface of the glass pane along each of opposite side edges of the glass pane, the guide means interacting with edges of the darkening device, a support brace (38) mounted on the inside surface along one of front and rear transverse edges of the glass pane, the support brace having a motor drive (35) for driving the darkening device. The glass pane is adapted to be mounted on peripheral edges by cementing (using foam 3). Each

Art Unit: 3612

guide means is mounted by cementing on the inside surface of the glass pane (using foam 3). The support brace is mounted on the inside surface of the glass pane by cementing (using foam 9). The darkening device comprises a roll-up blind (17) which is permanently connected to the brace.

Bohm et al. does not disclose the front and rear roof element having a rabbet on edges that border the opening or the darkening device comprising louvers.

Bohm et al. does teach the use of peripheral rabbets on side elements (as seen in figure 2)

It would have been an obvious matter of design choice to modify a roof module, such as that above, to be used on a vehicle having front and rear roof elements with rabbets since applicant has not disclosed that this particular feature solves any stated problem or is for any particular purpose and it appears the device would perform equally well without the rabbets.

Clenet teaches the use of louvers (34).

It would have been an obvious matter or design choice to modify a darkening device, such as that disclosed by Bohm et al., to be comprised of louvers, as taught by Clenet, since applicant has not disclosed that this particular type of darkening device solves any stated problem or is for any particular purpose and it appears the darkening device would perform equally well comprised of a sheet material.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paetz et al., Ohkubo, Comert et al., Stallfort et al., de Gaillard, Bohm et al. '872, DE 019955710, and DE 10218601 all disclose vehicle roofs.

Art Unit: 3612

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason S. Morrow whose telephone number is (703) 305-7803. The examiner can normally be reached on Monday-Friday, 8:00a.m.-4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason S. Morrow  
Examiner  
Art Unit 3612

April 13, 2004

  
JASON MORROW  
PATENT EXAMINER

4/13/04